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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,173	10/06/2000	James R. Kittrell	00-625	3692

7590 10/09/2002

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[REDACTED] EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
1711	9

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-9

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/684,173	KITTRELL, JAMES R.
	Examiner Thao T. Tran	Art Unit 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 September 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 27 and 28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/324,574.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Request For Reconsideration***

1. This is in response to the Request For Reconsideration filed on September 26, 2002.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action has been withdrawn.
3. A new Non-Final rejection is included in this Office Action due to newly found prior art.
4. Claims 27-28 are currently pending in this application.

### ***Claim Rejections - 35 USC 102/§ 103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kramer et al. (US Pat. 6,086,749).

Kramer teaches a catalyst composite, comprising a combination of silica, titania, tungsten oxide, and platinum (see col. 37, ln. 2-20). Kramer further teaches tungsten oxide (Group VIB metal) to be about 0.5 to about 50% by weight; platinum (Group VIII metal) about 0.1 to about 10% by weight; and that the total metal components would be about 0.1 to about 60% by weight of the total catalyst (see col. 37, ln. 32-51), overlapping the instantly claimed ranges. Thus, the total weight of silica and titania would inherently be about 40 to about 99.1%, overlapping the instantly claimed ranges.

Therefore, the subject matter as a whole would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have selected the overlapping portion as taught by Kramer, because overlapping ranges have been held to be a *prima facie* case of obviousness. See MPEP 2144.05.

8. Claims 27-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamner et al. (US Pat. 3,887,455).

Hamner teaches a catalyst composite, comprising tungsten oxide, platinum, silica, and titania (see col. 5, ln. 40-67). Hamner further teaches the catalyst comprising about 5 to about

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50%, or about 15 to about 25%, of tungsten oxide (oxide of Group VIB metal); and about 4 to about 8% of platinum (Group VIII metal) (see col. 5, ln. 42-48).

Thus, the total weight of silica and titania would inherently be about 6 to about 42% in Hamner's catalyst composition, which reads on the instantly claimed ranges. Since the weight of silica as presently claimed to be about 0.1 to about 70%, one can take silica as having zero concentration.

With respect to the platinum component, Hamner teaches the catalyst comprising about 4 to about 8% of platinum (see col. 5, ln. 46-47), overlapping the instantly claimed range. Therefore, the subject matter as a whole would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have selected the overlapping portion as taught by Hammer, because overlapping ranges have been held to be a *prima facie* case of obviousness. See MPEP 2144.05.

9. Claims 27-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over O'Hara (US Pat. 3640,817).

O'Hara teaches a catalyst composite, comprising about 4 to about 30% by weight of tungsten; about 1 to about 10% by weight of platinum; and a mixture of silica-titania (see col. 2, ln. 44-62). Thus, the amount of silica and titania would inherently be about 60 to about 96%, in which there is about 10 to about 90% weight of silica, which reads upon the instantly claimed ranges of silica and titania.

$\hookrightarrow \text{50 - 6\% } TiO_2$

With respect to the platinum component, O'Hara teaches the catalyst comprising about 1 to about 10% of platinum (see col. 5, ln. 46-47), overlapping the instantly claimed range. Therefore, the subject matter as a whole would have been obvious to one of ordinary skill in the

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art, at the time the invention was made, to have selected the overlapping portion as taught by O'Hara, because overlapping ranges have been held to be a *prima facie* case of obviousness. See MPEP 2144.05.

***Response to Arguments***

10. Applicant's arguments with respect to claims 27-28 have been considered but are moot in view of the new ground(s) of rejection above.

***Contact Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 703-306-5698. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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tt  
October 7, 2002



NATHAN M. NUTTER  
PRIMARY EXAMINER  
GROUP 1711